



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No.: 99-365)

In re Application of:
Schuster, et al.

Serial No.: 09/406,321

Filed: September 27, 1999

For: System and Method for Controlling
Telephone Service Using a Wireless
Personal Information Device

)
) Group Art Unit: 2681
)
) Examiner: Davis, Temica M.
)
) Confirmation No.: 1481
)
)
)
)

RECEIVED

SEP 22 2004

Technology Center 2600

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION PURSUANT TO 37 C.F.R. § 1.131

Dear Sir:

We, Guido M. Schuster, residing at Rötelssteig 9, CH-8037 Zürich, Switzerland; Ikhlaz S. Sidhu, residing at 2502 Branch Road, Champaign, Illinois 61822; Jerry J. Mahler, residing at 5510 Fox Path Lane, Hoffman Estates, Illinois 60192; Frederick D. Dean, residing at 921 12th street, Wilmette, Illinois 60091; and Jacek A. Grabiec, residing at 7236 West Coyle, Chicago, Illinois 60631, hereby declare:

1. We are the named inventors on United States Patent Application Serial No. 09/406,321, filed on September 27, 1999.

2. The embodiments of the invention disclosed in the above-captioned patent application were conceived cooperatively by Guido M. Schuster, Ikhlal S. Sidhu, Jerry J. Mahler, Frederick D. Dean, and Jacek A. Grabiec at least prior to August 12, 1999. ✓

3. Accompanying this Declaration is (i) Exhibit A containing a photocopy of pages of a 3Com Invention Disclosure Form that contain a brief description of the invention illustrating conception of our invention; and (ii) Exhibit B containing photocopies of a further description and illustration of embodiments of the invention, and thus exemplifying due diligence toward a reduction to practice.

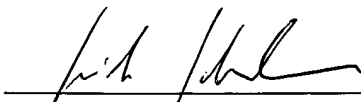
4. The dates have been redacted from these photocopies; however the dates illustrate that the invention disclosed in the above-captioned patent application was conceived at least before August 12, 1999 (i.e., the filing date of United States Patent No. 6,516,202 to Hawkins et al.), and diligently reduced to practice from at least before August 12, 1999 to a subsequent reduction to practice.

5. Our invention was conceived and diligently reduced to practice in the United States.

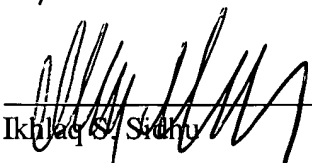
6. We hereby declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: September 6-2004

Signed: 
Guido M. Schuster

Date: July 8, 2004

Signed: 
Ikhlas S. Sidani

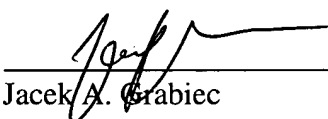
Date: August 10, 2004

Signed: 
Jerry J. Mahler

Date: Aug 23, 2004

Signed: 
Frederick D. Dean

Date: July 25, 2004

Signed: 
Jacek A. Grabiec

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2515.84.058

99.365

This is an Information Disclosure Form for 3Com Corporation and all of its related companies, hereafter referred to as "COMPANY."

Instructions:

- Complete all sections. Attach supplemental pages and other materials.
- Provide enough information to understand your invention.
- Any questions regarding this form or how to fill it out, refer to Kim Clinger (408 326-1754) or Bill Becker (408 764-5485) by phone or e-mail.
- Return Completed Form To: Legal Department - M.S. 1308
5400 Bayfront Plaza
Santa Clara, California 95052-8145

Date Stamp: _____

1. Title of the Invention

Write a short descriptive title, avoiding coined terms and project names.

Wireless PDA based control of an Internet Telephony System

2. Inventors

Include names of all persons who made a contribution to the conception and/or reduction to practice of the invention. If there are more than five inventors, use a Supplemental Sheet.

Full Name:	Guido Schuster	M.S. & Location	T
Home Address:	1433 Perry Street #408, Des Plaines, IL 60016		
Home Phone:	(87) 699 0360	Work Phone:	(847) 222 2486
Employee No.	19261	Division:	PCBU
Supervisor:	Ikhlag Sidhu	Department:	S4
Citizenship:	Switzerland	:	
Full Name:	Ikhlag Sidhu	M.S. & Location	
Home Address:			
Home Phone:		Work Phone:	
Employee No.		Division:	
Supervisor:		Department:	S4
Citizenship:		:	
Full Name:	Rick Dean	M.S. & Location	
Home Address:			
Home Phone:		Work Phone:	
Employee No.		Division:	
Supervisor:		Department:	S4
Citizenship:		:	
Full Name:	Jerry Mahler	M.S. & Location	
Home Address:			
Home Phone:		Work Phone:	
Employee No.		Division:	
Supervisor:		Department:	S4
Citizenship:		:	
Full Name:	Jacek Grabiec	M.S. & Location	
Home Address:			
Home Phone:		Work Phone:	
Employee No.		Division:	
Supervisor:		Department:	S4
Citizenship:		:	

Check here and attach supplemental sheet if more than 5 inventors ☐

inventors' initials _____

Page 1 of ____

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3. Conception of the Invention

Date of conception: _____

Location of conception: UNet

Date of first written description: This is it

Location of such first description _____ Page(s): _____

Please attach copies of all pertinent lab notebooks or equivalent. They should be signed, dated and witnessed by two other people who have read and understood the description of the invention.

4. Reduction to Practice

Reduction to practice is demonstrating that an invention merely works with evidence such as working models, prototypes or simulations. Reduction to practice is not necessary to file a patent application.

Date of any such demonstration: none planned ☒

date/planned date of demonstration _____

Location of demonstration: _____

5. Invention Applicability/Project/Release/Sale Information

A sale, offer for sale, public showing or release of the invention may affect COMPANY's right to patent the invention. Submit this form even if a public sale, showing or release has occurred.

To which division or operation does this invention best apply?		S4
Field of technology (e.g., manufacturing, switches, hubs, routers, network management software, adapters, etc.)		Internet Telephony
Project name and description:	S4	
Product name and model number:		
Does this invention relate to an actual or proposed standard or defacto standard?	<input type="checkbox"/> NO <input checked="" type="checkbox"/> YES (name of std.) SIP/H.323/MGCP	
Please list docket numbers of all other invention disclosures that are related to this one:		
Estimated/actual date of first public release or showing of invention or product incorporating or using the invention:		
Estimated/actual manufacturing release date of invention or product incorporating or using the invention:		
Estimated/actual date of offer for sale of product incorporating or using the invention:		

inventors' initials _____

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6. Publication of the Invention

Publication of a description of the invention may affect COMPANY's right to patent the invention. Submit this form even if publication has occurred.

Has a description been published or is it scheduled to be published? No ☐ Yes ☒

If "Yes," when and to whom? _____

Has a description been disclosed or is it scheduled to be disclosed? No ☐ Yes ☒

If "Yes," when and to whom? _____

3Com Corporate Communications

Was a Non-Disclosure Agreement used? No ☐ Yes ☐

If "Yes," please attach copy. _____

Not sure

7. Government Agency Contract

Was this invention made under a government agency contract? No ☐ Yes ☐

If "Yes," government agency contract number: _____

8. Joint Development or Development Contract

Was this invention jointly developed with inventors from another company? No ☒ Yes ☐

If "Yes," please identify the company and/or non COMPANY inventors: _____

Was the invention tested, constructed or conceived pursuant to the performance of a development contract with another company? No ☒ Yes ☐

If "Yes," please identify the contract and its location: _____

9. Related Art

Is this invention an improvement of an existing COMPANY product? No ☐ Yes ☒

If "Yes," identify the existing product: S4 Internet Telephony

Closest known related art ("prior art"): Maybe Cell-phones

What was the problem to be solved? Control of the Telephone Network via a wireless PDA

How had others attempted to solved it before you? _____

What were the problems or disadvantages with prior solutions? _____

10. Key Words

Indicate any key words (preferably at least 3) we could use to search for related art or identify this invention for use in our own database.

PDA, Palm, Wireless, PSTN, Internet telephony,

inventors' initials _____

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11. Reference Materials

List any printed publications, patents, patent applications or any other materials you are aware of which provides background material and/or prior art for your invention _____

12. Brief Description of the Invention

Describe the structure, function and/or method of the invention in just enough detail to enable someone technical to understand your invention. Stress the fundamental principle of the new idea from an engineering standpoint. Attach all the relevant descriptive materials. You should reference/include any drawings/sketches that will help explain the invention.

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The basic concept is to control a telephony network using a wireless PDA (Personal Digital Assistant). A regular PSTN phone can be registered with a PDA by entering its phone number. In the proposed system, the wireless PDA can now be used to control that phone set. This is achieved through a set of SIP (session initiation protocol) servers and gateways.

The most basic service is dialing directly from the address book of the PDA. First the user needs to enter the phone number of its PSTN phone into the PDA. This will allow the network to ring that phone when the remote party takes the call. . This phone number is then transmitted (wirelessly) to a server in the Internet which holds the owners profile. That profile is then updated with this phone number. Now anybody in the address book of the PDA can be dialed by simply selecting that person in the address book. This will initiate, over the wireless link, a call to both parties, the one in the address book and the phone number under which the owner of the PDA is currently reachable. The same set-up can also be used to create a multiparty conference.

A more powerful service is that of personal mobility. After entering a room with a PSTN phone the user of a wireless PDA enters the phone number of the PSTN phone into his PDA. This phone number is then transmitted (wirelessly) to a server in the Internet which holds the owners profile. That profile is then updated with this phone number. Any call placed to the personal phone number of the PDA owner (which is not the phone number of the PSTN phone the owner is at right now) is now re-routed to the PSTN phone number. Note that this re-routing could be achieved via SS7, but this is not the preferred mode. Instead, the phone call is moved via an on-ramp gateway to the Internet, and then routed to the nearest off-ramp gateway.

While the above services are very useful, they also demonstrates the main concept behind this patent application: The use of a wireless PDA to control the behavior of an Internet based telephony server. This basically makes the wireless PDA a user interface for the telephony network.

13. Drawings of the Invention

Please submit clear drawings and/or sketches which illustrate the invention either by electronically inserting them into Section 12 or using the supplemental sheets if you can't easily electronically insert them.

inventors' initials _____

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14. Licensing/Competitive Analysis

Is this a licensable technology? No ☐ Yes ☐ Don't know ☒

If "Yes," name the fields in which this might be licensed: _____

If "Yes," name the companies which may possibly be interested: _____

15. Attorney

If there is a particular patent attorney with whom you would like to work on this disclosure,
suggest his/her name. Larry Aaronson

16. Signatures of Inventors

This Invention Disclosure Form is submitted pursuant to your employment agreement with COMPANY. Use a Supplemental Sheet if there are more than 5 inventors. Please sign and date below and be certain that each page of this disclosure has been initialed by each inventor.

Signature: _____ Date: _____

Signature: _____ Date: _____

Signature: _____ Date: _____

Signature: _____ Date: _____

Signature: _____ Date: _____

17. Witnesses: Read and Understood

This Invention Disclosure Form consisting of _____ pages has been read and understood by:

Name: _____ Name: _____

Signature: _____ Signature: _____

Date: _____ Date: _____

Witnesses, please initial all supplemental pages.

inventors' initials _____

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This is a SUPPLEMENTAL INVENTOR SHEET which is to be used if there are more than 5 inventors for the invention set out in the Invention Docket specified above.

2. Additional Inventors

Include names of all persons who made a contribution to the conception and/or reduction to practice of the invention. If there are more than five inventors, use a Supplemental Sheet.

Full Name:	M.S. & Location		
Home Address:			
Home Phone:	Work Phone:		
Employee No.	Division:		
Supervisor:	Department:		
Citizenship:	:		
Full Name:	M.S. & Location		
Home Address:			
Home Phone:	Work Phone:		
Employee No.	Division:		
Supervisor:	Department:		
Citizenship:	:		
Full Name:	M.S. & Location		
Home Address:			
Home Phone:	Work Phone:		
Employee No.	Division:		
Supervisor:	Department:		
Citizenship:	:		
Full Name:	M.S. & Location		
Home Address:			
Home Phone:	Work Phone:		
Employee No.	Division:		
Supervisor:	Department:		
Citizenship:	:		
Full Name:	M.S. & Location		
Home Address:			
Home Phone:	Work Phone:		
Employee No.	Division:		
Supervisor:	Department:		
Citizenship:	:		

inventors' initials _____

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This is a SUPPLEMENTAL INFORMATION SHEET to be used to provide additional information regarding the invention disclosure referenced above.

Item _____

inventors' initials _____

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MCDONNELL BOEHLEN HULBERT & BERGHOFF

MBHBENRIQUE PEREZ
DIRECT DIAL (312) 913-2104
E-MAIL PEREZ@MBHB.COM32ND FLOOR
300 SOUTH WACKER DRIVE
CHICAGO ILLINOIS 60606
TELEPHONE (312) 913-0000
FACSIMILE (312) 913-0002***PRIVILEGED AND CONFIDENTIAL***

Guido Schuster
Ikhlalq Sidhu
Rick Dean
Jerry Mahler
Jacek Grabiec
3Com Corporation
1800 West Central Road
Mt. Prospect, IL 60056

Re: **U.S. Patent Application**
"Wireless PDA Based Control Of An Internet Telephony System"
Inventors: Guido Schuster, Ikhlalq Sidhu, Rick Dean, Jerry Mahler, Jacek Grabiec
MBHB Case No. 99,365
3Com Docket No. 2515.S4.US.P

Gentlemen:

This is to inform you that I will be preparing a patent application for the above-identified invention. I have briefly reviewed your invention disclosure. Your work is very interesting. I look forward to learning more about your invention and on working with you on your application.

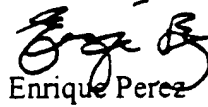
As I understand your disclosure, your invention is a system and method for controlling an Internet telephony system using a PDA. Your disclosure describes a method by which a user may initiate a telephone call by selecting an entry in the address book of the user's PDA. The PDA interfaces by a wireless connection to a session control system and initiates a telephone connection to the party identified in the address book. The session control system also initiates a telephone connection to the user's PSTN telephone and ensures that the parties connect to each other over the Internet telephony system.

According to your disclosure, the user's PSTN telephone number is registered with the user's profile in the session control system so that the telephone number is always used for one of the parties. In another feature described in your disclosure, the user may change the PSTN telephone number in his profile so that telephone connections may be initiated to the nearest PSTN telephone regardless of where the user may be.

I have attached a block diagram illustrating my understanding of your invention as described in your disclosure. I welcome any comments that you may have regarding this diagram. I hope to use this as Figure 1 of your application.

Unless otherwise instructed, I will be contacting Mr. Schuster with more detailed questions regarding your invention in the coming weeks. Please feel free to call me if you have any questions or comments about the patent application process. I can also be reached by 3Com's e-mail system.

Very truly yours,



Enrique Perez

EP:tmp

Enclosure

cc: Patti Contreras
Holly Mueller
Bradley J. Hulbert

Event A: Initiate telephone connection to User 2.

Event B: connection to User 1.

